

Application No.: 10/647,895**Docket No.: 4605-001****REMARKS**

Claims 35-38 have been cancelled because the undersigned attorney for Applicants very recently became aware of the fact that the structure defined by claim 35 is not novel. To expedite prosecution, claims 36, 37 and 38 are also cancelled.

The indication of claims 18, 19 and 30 being allowed and of claims 22-29 containing allowable subject matter is noted.

Applicants traverse the rejection of claims 15, 16 and 35 as being anticipated by Springston, U.S. Patent 4,247,261. In rejecting these claims, the Examiner admits he has ignored the requirement in the claims for the propeller, while turning and while the water craft is moving forward in a body of water, to be able to (1) suck water from the body of water into the interior of a sheath via at least one opening in the sheath, (2) force the sucked water upwardly, and (3) force the upwardly forced water through another opening in the sheath below the surface of the body of the water. The Examiner has also ignored the statement that these actions cause the water forced through the other opening to have a speed greater than the speed of the water sucked into the sheath and cause air bubbles to be introduced in the water above another opening.

The Examiner relies on the statement in column 4, lines 49-51 of the Springston patent. However, complete consideration of this portion of the Springston patent, i.e., column 4, lines 46-49 indicates that water pumping device 20 of Springston may be operated in a position at rest at the bottom of the body of water. The Springston patent then goes on to indicate that this mode of operation, i.e., operation in a position at rest at the bottom of the body of water, is particularly suitable when the water pumping device is suspended from a boat. In other words, the Springston patent indicates that when the deicer is mounted on a boat, the boat remains at rest and, thus, is not moving forward. Consequently, there is no basis in the Springston patent to conclude that there is

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any teaching or disclosure in Springston of the foregoing requirements of claim 15, upon which claims 16 and 34 depend.

The Springston patent also indicates water pumping device 20 includes an electric drive motor 30, rated at one-third horsepower, which draws approximately 11½ amperes at 1750 rpm. A typical boat of the type that would include the Springston device does not have an electric power source on board to drive such a motor. Instead, such a motor is driven by a shore supply for a docked boat.

The enclosed Declaration by John Blumenthal, the President of Powerhouse, Inc., the owner of the Springston patent, indicates the device disclosed in the Springston patent has been sold as a deicer for approximately the last 25 years. To the knowledge of Mr. Blumenthal, when such a device has been used on a boat, the boat has always been docked and electric power to the motor of the device has always been supplied by a shore supply, and the boat has never been moved while the motor was turning.

The Examiner's refusal to consider all the words of claim 15 is contrary to established law. Every word of a claim must be considered for making a determination of patentability. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Functional statements in structure or apparatus claims must be considered. In re Swinehart, 166 F.2d 210, 169 USPQ 226 (CCPA 1971). In the Swinehart case, the sole point of novelty was the functional requirement for the material to be opaque to infrared energy.

The situation in the present case is somewhat similar to that of In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the Mills case, the claims were directed to an apparatus for producing aerated cementitious composition by driving an output pump at a capacity greater than the feed rate of the material being supplied to the pump. The Patent and Trademark Office in that case

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had ignored the requirement for the output pump capacity to be greater than the feed rate. The court ruled that consideration must be given to this limitation, and reversed the position of the Patent and Trademark Office. In a similar manner, the claims of the present application require certain things to happen while a water craft is moving forward in a body of water and a propeller is turning. These limitations cannot be ignored, based on the foregoing decisions.

Because claims 16 and 34 depend on claim 15, claims 16 and 34 are patentable with claim 15. Similarly, because claims 17, 20, 21 and 31-33, which are rejected as being obvious as a result of Springston, depend on claim 15, claims 17, 20, 21 and 31-33 are allowable.

In view of the foregoing amendments and remarks, allowance is in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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